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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,315	01/02/2004	Andre Wachholz-Prill	13906-154001 / 2003P00704	2006
32864	7590	12/04/2006	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			BIBBEE, JARED M	
			ART UNIT	PAPER NUMBER

2169

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/751,315

Applicant(s)

WACHHOLZ-PRILL, ANDRE

Examiner

Jared M. Bibbee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/2/2004, 2/2/2004, 5/10/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-33 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1 and 33 it is clear that the claim language simply represents an abstract idea where a set of attributes are compared to a set of rules and then based on the comparison a determination is made as to what action is to be taken by the computer system with regards to the data object, but fails to provide a useful, concrete, and tangible purpose or result. Applicant is reminded that patent protection is limited to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Since the claims presented by the applicant are indeed simply abstract ideas, the claims are not covered by the statutory categories of patentable subject matter set forth in 35 U.S.C. 101. An abstract idea is categorized as one of the three judicially created exceptions to patentable subject matter (the three exceptions are Laws of Nature, Natural Phenomena, and Abstract Ideas). The courts have concluded that in order to patent on of the three judicial exceptions to the statutory categories of the invention the claimed subject matter must have a

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practical, real-world application that produces a useful, concrete, and tangible result (*State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02).

In order to overcome this rejection, the applicant must add a final limitation to independent claims 1 and 33 showing a step of actually presenting the determined action outcome to a user in the form of a view. This final step is shown in Fig. 4 of the drawings included with the applicant's specification, using the display device (210) in Fig. 2. By adding this conclusionary step, the applicant will add to the claimed invention a useful, concrete, and tangible result that arises from a practical application of the method steps previously mentioned in the claim.

Claims 2-7 are rejected because they inherit or contain the deficiencies of claim 1 respectively.

With respect to claims 8 and 28, these claims are rejected under 35 U.S.C. 101 because the invention, as claimed, appears to be directed to merely an abstract idea. The Examiner makes this assertion because the claim simply recites providing certain components, assigning certain values, and processing entities with no attempt to tie all of the steps together in order to carry out a final, conclusionary step. Applicant is reminded that patent protection is limited to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Since the claims presented by the applicant are indeed simply abstract ideas, the claims are not covered by the statutory categories of patentable subject matter set forth in 35 U.S.C.

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101. An abstract idea is categorized as one of the three judicially created exceptions to patentable subject matter (the three exceptions are Laws of Nature, Natural Phenomena, and Abstract Ideas). The courts have concluded that in order to patent on of the three judicial exceptions to the statutory categories of the invention the claimed subject matter must have a practical, real-world application that produces a useful, concrete, and tangible result (*State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02).

In order to overcome this rejection, the applicant must amend independent claims 8 and 28 such that the claims provide a final, conclusionary step. This final step should tie together all previously recited steps. This final step is shown in Fig. 4 of the drawings included with the applicant's specification, using the display device (210) in Fig. 2. By adding this conclusionary step, the applicant will add to the claimed invention a useful, concrete, and tangible result that arises from a practical application of the method steps previously mentioned in the claim. Finally, the claimed invention as a whole must set forth a practical application of the invention, which provides a useful, concrete, and tangible result. Correction of this deficiency is required.

Claims 9-27 and 29-32 are rejected because they inherit or contain the deficiencies of claims 8 and 28 respectively.

Additionally with respect to claim 33, the claim is rejected under 35 U.S.C. 101 because it also appears that the computer program product containing executable instructions that is claimed by the applicant is not limited to physical articles or objects, which are structurally and functionally interrelated to the instructions in such a manner that would enable the instructions to act as a computer component and realize any functionality. On page 15, lines 6-9, the applicant states that the computer program product containing executable instructions of the invention can

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be embodied in an 'information carrier'. The applicant further states that the 'information carrier' includes "propagated signals". This type of communication medium or transmission medium is not limited to media, which meet the criteria set forth above.

The claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759.

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8-(noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Appropriate clarification and/or correction is required. It is noted that in this instance, Applicant's specification clearly distinguishes between media, which "store" versus communications media, which would "convey" the instructions. Therefore, an amendment to the

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claims to recite a 'physical machine readable storage medium' rather than 'computer program product containing executable instructions' would be favorably considered.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7 and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, Applicant uses the word 'capable', which renders the claim indefinite because the word 'capable' does not clearly define as to whether the system takes action or does not take action. Examiner suggests replacing 'capable' and rewording the preamble to use such words as "causing, consisting, comprising, or etc.". Appropriate correction is required.

Additionally with respect to claim 1 and 33, on pages 17 and 22 lines 11-16 and 11-16 respectively, Applicant phrases this particular aspect of the claims using an 'if' statement, which renders the claims indefinite because it is unclear as to whether there is an outcome or determined result. Examiner suggests rewording the claims such that the 'if' is replaced and the phrase "determine" is used instead.

Claims 2-7 are rejected because they inherit or contain the deficiencies of claim 1 respectively.

***Allowable Subject Matter***

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5. Claims 1-33 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grimmer et al (U.S. 6,438,544 B1) is cited to teach a method and apparatus for dynamic discovery of data model allowing customization of consumer applications accessing privacy data.

Wong et al (U.S. 6,578,037 B1) is cited to teach a partitioned access control to a database.

Veronese et al (U.S. 2004/0210445 A1) is cited to teach a method and system for specifying and implementing business applications.

***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared M. Bibbee whose telephone number is 571-270-1054. The examiner can normally be reached on 5/4/9.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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